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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,282	09/30/2002	John F. Braun	F-522	5697
919	7590	02/07/2006	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			NGUYEN, KIMNHUNG T	
			ART UNIT	PAPER NUMBER
			2677	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/065,282

Applicant(s)

BRAUN ET AL

Examiner

Kimnhung Nguyen

Art Unit

2677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE and Amendment filed on 11/1/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Application has been examined. The claims 1-17 are pending. The examination results are as following.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/01/2005 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3,5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 6,681,045) in view of Denoue et al. (US 6,773,177).

Regarding claim 1, Lapstun et al. discloses in figure 8, a method for associating metadata with a document having a metadata storage device attached to the document (see computer system having handwritten on a paper associate with identify and coded data, see column 2, lines 57-67) comprising initializing a pointing instrument for capturing pen stroke data (see fig. 38,

Art Unit: 2677

see col. 19, lines 43-45) using the document (pen 101, figure 8); processing pen stroke data in a normal data capture mode using the document; recognizing a metadata mode (see figure 49); then capturing pen stroke meta data using the pointing instrument using the document(see handwritten on a paper) sending the metadata to a processor; then receiving processed metadata created using the metadata from the processor (see column 2, lines 20-34); and then storing the processed metadata in the metadata storing device that is attached to the document (see column 36, lines 5-10), wherein the processed meta data includes text data (see figs 53-55, col. 48, lines 27-33).

However, Lapstun et al. does not disclose a document having a metadata dynamic read-write storage device.

Denoue et al. discloses in fig. 3, a document having a metadata dynamic read-write storage device (110, see col. 15, lines 34-58, and col. 23, lines 13-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the document having a metadata dynamic read-write storage device as taught by Deoue et al. into the system of Lapstun et al. because this would be read and written by the central processing (CPU) (see col. 23, lines 13-23), which update the new data and therefore will make the system work more faster.

Regarding claim 2, Lapstun et al. discloses that receiving a process metadata command (see figure 38), wherein the pointing instrument is a digital pen (101, figure 8-9, 21), and wherein a user uses the digital pen and the document to generate the process metadata command; and assigning an unique serial number to the metadata (see col. 48, lines 34-42).

Regarding claim 3, Lapstun et al. discloses further, wherein the metadata is pen stroke data (884) captured from a predefined area of the document (see fig. 38, see col. 19, lines 43-45),

Regarding claims 5-6, Lapstun et al. discloses further wherein the metadata is pen stroke data captured using the digital pen and document from first subset or all pen strokes made on the document (see column 4, lines 53-57).

Regarding claim 7, Lapstun et al. discloses that wherein the metadata includes biometric data (see figure 21).

Regarding claim 8, Lapstun et al. discloses the method comprising storing an e-copy of the document strokes to the metadata storage (see print a copy of document, see column 25, lines 50-57).

Regarding claim 9, Lapstun et al. discloses the method of claim 2 wherein the metadata storage device comprises an integrated circuit (see col. 42, lines 12-31).

Regarding claim 10, Lapstun et al. discloses that the method of claim 1 wherein the document comprises a piece of paper (see page number, see fig. 56).

Regarding claim 11, Lapstun et al. discloses further wherein the document comprises a spiral bound book (see col. 48, lines 23-24).

Regarding claim 12, Lapstun et al. discloses further comprising: cryptographically processing the metadata using authentication data (see col. 32, lines 40-46, and col. 19, lines 51-53).

Regarding claim 13, Lapstun et al. discloses further comprising: discontinuing capturing metadata data after sufficient data to create a biometric signature is obtained (see fig. 21).

Regarding claim 14, Lapstun et al. discloses further the metadata s a subset of the metadata data (see fig. 38).

Regarding claim 15, Lapstun et al. discloses a method for associating metadata with a document having a metadata storage device comprising: receiving metadata data from a digital pen (see pen 101) using the document; processing the metadata data to determine a biometric signature; sending metadata to the digital pen including the biometric signature (see fig. 21, see col. 2, lines 57-67 and col. 366, lines 5-10); and then storing the processed meta data in the metadata storage device that is attached to the document.

However Lapstun et al. does not disclose a document having a metadata dynamic read-write storage device.

Denoue et al. discloses in fig. 3, a document having a metadata dynamic read-write storage device (110, see col. 15, lines 34-58, and col. 23, lines 13-23) as discussed above.

Regarding claim 16, Lapstun et al. discloses further comprising cryptographically processing the metadata (see col. 32, lines 40-46).

Regarding claim 17, Lapstun et al. discloses that wherein the metadata includes an e-copy representation of stroke data received from the digital pen (see print a copy of document, see column 25, lines 50-57).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 6,681,045) and Denoue et al. (US 6,773,177) in view of Rekimoto et al. (US 6,795,060).

Lapstun et al. and Denoue et al. disclose every feature of the claimed invention, excluding wherein the metadata storage device is comprises an rf-id tag.

Rekimoto et al. discloses in fig. 10, the storage device having rf-id tag, see abstract, see col. 15, lines 9-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the storage device having rf-id tag as taught by Rekimoto et al. into the system of Lapstun et al. because this would provide to read identification data contained in each wireless tag and then activate a corresponding processing operation of the system (see abstract), which corresponding to individual function or application program for the user.

Art Unit: 2677

***Response To Arguments***

6. Applicant's arguments with respect to claims 1-17 filed on 11/1/05 have been considered but are moot in view of the new ground(s) of rejection.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimnhung Nguyen whose telephone number is (571) 272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimnhung Nguyen  
January 26, 2006

AMR A. AWAD  
PRIMARY EXAMINER

